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Paper No.

BAXTER HEALTHCARE CORPORATION  
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MAIL STOP DF2-2E  
DEERFIELD, IL 60015

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**FEB 07 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Scheifflinger et al. : DECISION ON APPLICATION  
Application No. 09/661,992 : FOR  
Filed: September 14, 2000 : PATENT TERM ADJUSTMENT  
Atty Docket No. 237.00 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT CORRECTION," filed March 23, 2005. This paper was recently forwarded to the undersigned for consideration. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred sixteen (116) days to one hundred thirty-two (132) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **ninety-six (96)** days (not 132 days). A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 29, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 116 days. On March 23, 2005, applicants timely submitted an application for patent term adjustment (with required fee)<sup>1</sup>. Applicants dispute the period of adjustment for Office failure to mail a first action under 35

<sup>1</sup> PALM records indicate that the Issue Fee payment was filed on April 1, 2005.

U.S.C. 132. Applicants maintain that in accordance with 37 C.F.R. 1.703, the period of adjustment for Office delay in mailing the first Office action under 35 U.S.C. 132 is 650 days. Applicants argue that the Office should have used the date of mailing of the restriction requirement, August 26, 2003, and not the date of mailing of a Notice to Comply with Sequence Requirements, February 6, 2003, in calculating this period. Further, applicants state that using the later date the period under 35 U.S.C. 132 is 650 days..

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

As to the reduction pursuant to § 1.703(a)(1), applicants are correct. As stated in the final rule,

Section 1.703(a)(1) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(i). Section 1.703(a)(1) specifies that the period is the number of days, if any, beginning on the date after the day that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application and ending on the mailing date of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. A written restriction requirement, a written election of species requirement, a requirement for information under 1.105, an action under Ex parte Quayle, 1935 Comm'r Dec. 11 (1935), and a notice of allowability (PTOL-37) are each an action issued as a result of the examination conducted pursuant to 35 U.S.C. 131. As such, each of these Office actions is a notification under 35 U.S.C. 132. Office notices and letters issued as part of the pre-examination processing of an application are not notices issued as a result of an examination conducted pursuant to 35 U.S.C. 131, and thus are not notifications under 35 U.S.C. 132. Examples of such notices are: a Notice of Incomplete Nonprovisional Application (PTO-1123), a Notice of Omitted Item(s) in a Nonprovisional Application (PTO-1669), a Notice to File Missing Parts of Application (PTO-1533), a Notice of Informal Application (PTO-152), a Notice to File Corrected Application Papers Filing Date Granted (PTO-1660), or a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661).

The period of adjustment is 650 days based on the mailing of a first Office action on August 26, 2003 (counting the number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), November 15, 2001, and ending on the date of mailing of an action under 35 U.S.C. 132, the restriction mailed August 26, 2003).

However, a review of the record also reveals further basis for reduction of the patent term adjustment. First, of all, a reduction of 33 days is entered pursuant to § 1.704(b). Applicants took in excess of three months to file a response to the Notice to File Missing Parts mailed November 15, 2000. A response was not received until March 20, 2001, three months and 33 days later.

Secondly, the reduction associated with applicants' filing of a response to a letter to comply with the sequence rules filed November 1, 2002 is corrected from 31 days to 203 days. This reduction was entered pursuant to 1.704(b); however, this reduction should have been entered pursuant to 1.704(c)(7). 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

By letter mailed July 1, 2002, applicants were advised that the response filed April 12, 2002 contained an omission. On November 1, 2002, applicants filed a response correcting the omission. The period of applicant delay runs from April 13, 2002 to November 1, 2002, a period of 203 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is ninety-six (96) days (650 days of Office delay reduced by 554 days (33 + 31 + 203 + 160 + 36 + 91) for Applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a large loop at the end.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Attachment: Copy of Revised PAIR Screen

# PALM INTRANET

Day : Tuesday  
Date: 2/7/2006  
Time: 10:22:17

## PTA Calculations for Application: 09/661992

Application Filing Date:	09/14/2000	PTO Delay (PTO):	465
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	349
Post-Issue Petitions:	0	Total PTA (days):	96
PTO Delay Adjustment:	-20		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
92	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	650		
91	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		16	
90	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		449	
89	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		203	
88	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	31		
87	02/07/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		33	
76	12/29/2004	MAIL NOTICE OF ALLOWANCE			
75	12/27/2004	ISSUE REVISION COMPLETED			
74	12/27/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
73	12/27/2004	NOTICE OF ALLOWABILITY			
72	12/21/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
71	12/17/2004	DATE FORWARDED TO EXAMINER			
70	12/10/2004	AMENDMENT AFTER FINAL REJECTION			
69	12/10/2004	WORKFLOW INCOMING AMENDMENT IFW			
68	11/22/2004	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
67	11/17/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
66	09/13/2004	MAIL FINAL REJECTION (PTOL - 326)			
65	09/07/2004	FINAL REJECTION			
64	07/26/2004	DATE FORWARDED TO EXAMINER			
63	07/02/2004	RESPONSE AFTER NON-FINAL ACTION		91	58
62	07/02/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
61	07/02/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			

60	07/19/2004	CORRESPONDENCE ADDRESS CHANGE			
59	07/02/2004	WORKFLOW INCOMING AMENDMENT IFW			
58	01/02/2004	MAIL NON-FINAL REJECTION			
57	12/29/2003	NON-FINAL REJECTION			
56	11/14/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		36	53
55	11/14/2003	REFERENCE CAPTURE ON IDS			
54	10/14/2003	DATE FORWARDED TO EXAMINER			
53	10/09/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
52	10/09/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	08/26/2003	MAIL RESTRICTION REQUIREMENT	16		47
50	08/25/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
49	07/25/2003	CASE DOCKETED TO EXAMINER IN GAU			
48	05/13/2003	DATE FORWARDED TO EXAMINER			
47	04/10/2003	RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES		160	39
46	04/10/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	02/06/2003	MAIL NOTICE OF RESTARTED RESPONSE PERIOD	449		-1
44	02/05/2003	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
43	01/15/2003	MAIL INCOMPLETE RESPONSE TO SEQUENCE RULE REQUEST			
42	01/15/2003	INCOMPLETE RESPONSE TO SEQUENCE RULE REQUEST			
41	11/26/2002	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
40	11/14/2002	DATE FORWARDED TO EXAMINER			
39	11/01/2002	RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES		31	36
38	11/01/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
36	07/01/2002	MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED)			
35	07/01/2002	CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED			
15	05/02/2002	ERROR(S) IN CRF CORRECTED BY STIC			
14	04/23/2002	DATE FORWARDED TO EXAMINER			
		RESPONSE TO A LETTER TO COMPLY WITH THE			

13	04/12/2002	SEQUENCE RULES		31	10
12	04/12/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
10	12/12/2001	MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED)			
9	12/12/2001	CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED			
8	03/30/2001	CASE DOCKETED TO EXAMINER IN GAU			
7	03/02/2001	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
6	03/26/2001	APPLICATION DISPATCHED FROM OIPE			
5	03/26/2001	APPLICATION IS NOW COMPLETE			
4	11/15/2000	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	11/14/2000	CORRESPONDENCE ADDRESS CHANGE			
2	10/12/2000	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/14/2000	INITIAL EXAM TEAM NN			

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#### **EXPLANATION OF PTA CALCULATION**

#### **EXPLANATION OF PTE CALCULATION**

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